

REMARKS

Status of the claims

In his September 10, 2003, Office Action, the Examiner rejected claims 1-20 based on obviousness. Applicant has amended claim 1 to overcome the section 103 rejections. In addition, Applicant has added claims 21-25, the subject matter of which is supported by pages 2-3 and 8-17 and Figures 2-20.

Section 103 Rejections

The Examiner maintained the rejection of claims 1-20 under 35 U.S.C. § 103(a) as being unpatentable over Sevcik et al., U.S. Patent No. 6,330,542 B1, entitled "Automated Internet Quoting and Procurement System and Process for Commercial Printing."

Applicant has amended claim 1 and respectfully requests reconsideration and withdrawal of the rejection in light of that amendment and the following arguments.

The Examiner's office action focused significant attention on dictionary definitions of the words "profile" and "predeterminable." See OA at 6. The Examiner also noted that certain structural elements described and argued in the previous response were not recited in the claims. Accordingly, Applicant has amended claim 1 to define minimal content for the predeterminable profile and to add the following elements:

- providing a *prototypical product record* that is *company-tailored*;
- providing, as a part of the prototypical product record, a *template defining the placement and typography of a plurality of informational elements* for printing on a company-tailored business card or stationery product;
- providing that the predeterminable profile *defines content for one or more of the informational elements* provided by the template; and
- providing a requestor interface that enables the user to select and order a company-tailored business card or stationery product *according to the company-tailored prototypical product record and a predeterminable profile*.

These amendments distinguish the claimed invention from Sevcik because:

- Sevcik provides an interface with which customers can procure quotes for printing jobs in accordance with a catalog of stationery and business card products. Sevcik provides the same catalog to all of its customers. Sevcik does not teach, disclose or suggest a prototypical product record for a specific company that includes a template defining the placement and typography of informational elements to be printed on a business card or stationery product.

- While Sevcik enables a customer to select and order a print job from an online catalog, Sevcik does not teach, disclose, or suggest limiting that selection to a company-tailored prototypical product record and a predeterminable profile that defines content for one or more of the informational elements provided by the template.
- Finally, as argued in Applicant's previous response, Sevcik does not teach, disclose, or suggest processing the user's print order through a processor interface, said processor interface being adapted to directly generate a pre-press product automatically incorporating said predeterminable profile into said tailored product.

Applicant has also added a new independent claim (claim 21), comprising the following elements:

- a computerized representation of a set of printable stationery products;
- customized templates corresponding with each stationery product in the set, wherein the template defines a plurality of common and specific informational elements for printing on the stationery product, and wherein the template also defines the placement and typographical settings of the informational elements to be printed on the stationery product;
- predefined informational content for the common informational elements of the customized templates, including for at least one of the common informational elements informational content that identifies a specific organization;
- a requestor interface for entry of a print order by a user associated with the specific organization, the requestor interface being adapted to enable the user to select a stationery product from the set of printable stationery products, the requestor interface being further adapted to enable the user to define or select a profile comprising informational content for the specific informational elements of the customized templates but which denies the user any ability to define or modify one or more of the common informational elements of the customized templates; and
- a processor interface for fulfillment of the user's print order, said processor interface being adapted to automatically generate a pre-press product incorporating both the predefined informational content for the common informational elements of the customized templates and the informational content from the user-defined or user-selected profile.

Claim 21 is patentable over Sevcik because:

- Sevcik does not teach, disclose or suggest customized templates for stationery products that define a plurality of informational elements, along with the placement and typographical settings of those informational elements.

- Sevcik does not teach, disclose or suggest a system for providing predefined informational content for the common informational elements, including content identifying a specific organization.
- Sevcik does not disclose a requestor interface that enables the user to define the informational content of only the specific informational elements while denying the user the ability to define or modify the common informational elements.
- Finally, as argued in Applicant's previous response, Sevcik does not teach, disclose, or suggest processing the user's print order through a processor interface, said processor interface being adapted to directly generate a pre-press product automatically incorporating said predeterminable profile into said tailored product.

Applicant reiterates and incorporates by reference the arguments set forth in its response to the February 2003 Office Action regarding the teaching of Sevcik and its unsuitability for and teaching away from the modification urged by the Examiner. These arguments set forth further reasons why amended claim 1 and new claim 21 are patentable over Sevcik.

In addition, Applicant makes the following remarks in response to the Examiner's most recent Office Action.

To establish a prima facie case of obviousness, all of the following must be true: (1) all of the references relied upon must have been in the prior art (in a chronological sense); (2) all of the references must be either in the field of the inventor's endeavor or in a reasonably pertinent field; (3) the prior art must suggest the desirability of the claimed invention (i.e., a reason, suggestion or motivation for combining the teachings of the references to produce the claimed invention must be present in the prior art); (4) the combination or modification must teach or suggest *all* of the claimed limitations; (5) a person of ordinary skill in the art must have had a reasonable expectation that the combination or modification would succeed, and (6) the proposed combination or modification cannot render the prior art unsatisfactory for its intended purpose.

With italicized emphasis, the Examiner argues that Sevcik teaches that "[t]o *produce ordered* products, print providers receive information that is sufficient to create printed products and fulfill the orders." The Examiner then goes on to define the terms "produce," "ordered," and "procurement," a word found in Sevcik's title, Abstract, and specification:

- (1) the BARRONS Dictionary of Business Terms defines "procurement" as the acquisition of goods required to carry on an enterprise,
- (2) The MS WORD Thesaurus sets forth the following synonyms for the word "produce": create, make, manufacture, construct, fabricate, bring into being, turn out generate, **AND**
- (3) the BARRONS Dictionary of Business Terms defines "order" as a "request to buy, sell, deliver or receive goods or services that commits the issuer of the order to the terms specified,

On the basis of these dictionary and thesaurus references, the Examiner concludes that "Sevcik print providers receive information that is sufficient to create printed product." OA, at 5.

This is an exceptional argument. First, the Examiner's italicization of the phrase "*to produce ordered products*" suggests that Sevcik recites this function. But that pair of words does not appear together anywhere in Sevcik. Sevcik uses the word "produce" in the following contexts:

- "It is another objective of the invention to provide an auto intelligence type function that will give the buyer all of the available options to *produce* a particular project **at a given price** which might include **changing the paper selections, slightly altering the size of the project, or changing or omitting certain finishes** to allow the buyer to make the most informed buying decision." (col. 2, line 65 – col. 3, line 4 – *note that typographical settings are not specified*)
- "If the system cannot *produce* a **quote . . .**" (col. 13, lines 52-55).
- "*to produce* a second automated printing job **quote . . .**" (claims 1, 8, 16)

Third, the Examiner's reliance on definitions and synonyms for the words "produce," "ordered," and "procurement" is improper, particularly when definitions and synonyms are selected to contradict what Sevcik clearly means and teaches in its use of those words.¹ Applicant respectfully submits that the Examiner's combination of dictionary definitions and thesaurus terms does not establish a prima facie case of obviousness.

The Examiner argues that "Sevcik creates pre-press products via interfaces that use information from the profiles. Sevcik passes Pre-press product product data to print provider production systems for the purpose of creating, selling, and fulfilling orders for printed products." OA, at 7. Elsewhere, the Examiner argues that "Sevcik merges specific profile data, data entered via entry fields on various interfaces according to templates and prototypes to produce pre-press files." OA, at 9. Having read Sevcik, Applicant's attorney is not aware of any support for these assertions. Therefore, they are disputed.

On page 7, the Examiner places emphasis on the words "may require" in Sevcik's remark that "a Print Provider *may require* additional information about a job *in order to begin*." Sevcik's use of the permissive word *may* is to be expected. It is a patent, after all. One of the first tenets of patent drafting is to never use words like "must," "essential," and "critical" when defining an invention, lest the argument be made that the claims need be amended to incorporate the limitation.

¹ It is improper to rely on specific words of a carefully selected definition (one of many) of the word "procurement" to argue that Sevcik teaches something that it does not teach. Where a word is "used in so many senses, dependent upon the context, . . . the ordinary definitions of the dictionary throw but little light upon its signification in a given case." *Watt v. Western Nuclear, Inc.*, 462 U.S. 36, 42 (1983).

Sevcik's acknowledgement that additional information may be required does not prove the opposite. Sevcik does not teach or disclose sufficient information to enable a person of ordinary skill in the art to make and use a system in which the typography and placement of information elements is predefined so that such additional information is *not* required. See *Beakman Instruments, Inc. v. LKB Produkter AB*, 892 F.2d 1547, 1551, 13 U.S.P.Q.2d 1301, 1304 (Fed. Cir. 1989) ("In order to render a claimed apparatus of method obvious, the prior art must enable one skilled in the art to make and use the apparatus or method."); *In re Wilder*, 166 U.S.P.Q. 545, 548 (C.C.P.A. 1970) ("[A] prima facie case is made out whenever a reference is shown to contain a disclosure which is specific as to every critical element of the appealed claims. However, such disclosure may yet be held not to legally anticipate the claimed subject matter if it is found not to be sufficiently enabling, in other words, if it does not place the subject matter of the claims within 'the possession of the public.'") (emphasis added)

On page 7, the Examiner argues that Sevcik's disclosure of a "Job History" online tracking system proves that Sevcik also performs all of the prepress processing. Sevcik, however, does not state or teach or suggest that its system does the prepress processing. Moreover, Sevcik does not teach or disclose sufficient information to enable a person of ordinary skill in the art to make and use a system in which the typography and placement of information elements is predefined so that such additional information is *not* required.

The Examiner argues again, on page 9, that "[t]he output from Sevcik contains information sufficient to enable professional printers and typographers to bid on an order and fulfill an order." And on page 18, the Examiner argues that "Sevcik discloses that specific company tailored product (sic) is sufficient for professional printers an (sic) typographers to create competitive cost quotes."

Applicant respectfully disagrees. Yes, Sevcik provides enough information to enable printers to provide quotes. Yes, Sevcik assumes that print providers will receive additional information they need to fulfill the print order by some method or means, like contacting the customer. See Sevcik, col. 15, lines 19-22. But Sevcik does not indicate that *its system* provides sufficient information, e.g., about the placement and typographical settings of the informational elements to be printed on the stationery product, to create a printed product. Furthermore, Sevcik does not teach or disclose sufficient information to enable a person of ordinary skill in the art to make and use a system in which the typography and placement of information elements is predefined.

On page 9, the Examiner argues that "Sevcik merges specific profile data, data entered via entry fields on various interfaces according to templates and prototypes to produce a pre-press file."

Applicants submit that the amendment to claim 1 defines the terms "profile," "template," and "prototypical product record" in a manner that renders these arguments moot. Sevcik clearly does not provide prototypical product records or templates or a processor interface to merge information in the manner recited by amended claim 1.

The Examiner relies extensively on facts claimed to be within his personal knowledge regarding (1) what was generally available to persons of ordinary skill in the art at the time the invention was made; and (2) what factors would have motivated them to modify the embodiments disclosed in existing references. The Examiner argues, for example, that:

- (1) One of ordinary skill in the art of electronic commerce at the time the invention was made would have been motivated to include in Sevcik the use of various types of prior art command sets (such as direct-to-plate and copier command sets) for the obvious reason that professional printers may have many different types of printing machines, depending on their specialties. OA, at 3 – **This is disputed because, as argued previously, Sevcik teaches that the print provider, not Sevcik's system, fulfills the print order.**
- (2) Pre-press products may be command sets for direct-to-plate systems and for copier systems. OA, at 5 – **Agreed.**
- (3) Pre-press product product may differ depending on the type of system being used to produce a print product. OA, at 5 – **Agreed.**
- (4) One of ordinary skill in the art at the time the invention was made would have known that it is customary to send direct-to-plate command sets to systems that require plates or copier command sets to systems that produce printed products via electronic copiers. OA, at 5 – **Agreed that direct-to-plate command sets were known; disputed to the extent that the examiner is suggesting that it is "customary" to incorporate this in every system related to printing.**
- (5) A profile is a set of data that portrays the significant features of something. OA, at 6 – **Agreed.**
- (6) "It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Sevcik and predeterminable profiles." OA, at 13 – **Disputed. This remark assumes that Sevcik had some need or motivation for the combination, which, for the reasons described in the previous response, Sevcik does not.**
- (7) "One of ordinary skill in the art at the time the invention was made would have been motivated to combine Sevcik and predeterminable profiles for the obvious reason that many companies organize their business according to departments and authorizations of personnel within the company's organizational hierarchy." OA, at 13 – **Agreed only to the extent that the Examiner has admitted a long felt but unsolved need – companies have organized their businesses according to departments and authorizations of personnel ever since the invention, around 1440 A.D., of the Gutenberg press. But for the past 560+ years, no one has met that need in the manner claimed. This is evidence of nonobviousness. The Examiner's assertion is otherwise disputed. Sevcik does not even acknowledge any concern with how businesses are organized. Rather, as argued previously, Sevcik is concerned with providing a multi-print-provider platform for obtaining quotes and tracking job progress. Furthermore, the Examiner's remark suggests that Sevcik provided something (e.g., a template with fields for company-specific information to be printed on the stationery) with which to combine the predeterminable profiles. Sevcik only gathers user and company profile**

- information for billing purposes; it also gathers information about the size, type and binding or folding of the stationery, as well as information about ink colors or whether the printing will be double-sided. It however leaves to the user and the print provider the job of determining the actual informational content printed on the stationery and the typography of that content. For Sevcik to assume all of these tasks would not only dramatically increase the overhead of maintaining a Sevcik platform, but also leave no work, other than the actual printing and delivery of the printed product, for the print provider to do. Print providers would then be stripped of any control over the quality of the product, and yet they would be blamed for any dissatisfaction. This would not be a commercially feasible modification. Were one to modify Sevcik to this extent, that person would further modify Sevcik to assume responsibility for the actual printing of the product and eliminate the quote-provider platform. But this would render Sevcik unrecognizable and unfit for its intended purpose.
- (8) "On [sic] some employees may be authorized to act as purchase agents, for example. Perhaps as required by auditors and accounting rules, individuals may be able to place orders up to certain monetary limits. Individuals may also be authorized to replace a person who has quit or who might be under investigation for embezzlement." OA, at 13 – **Point not understood, therefore disputed.**
- (9) Professional print shops may use different types of machines, perhaps based on their specialties. Some shops may use copiers. Other shops may use machinery with plates. Each environment may accept binary files that contain instructions (i.e., command sets) to the machines. Sets of instructions intended for copiers may be called copier command sets. Instructions intended for plate machines may be referred to as direct-to-plate command sets. OA, at 13-14. – **Agreed.**
- (10) Machines may vary according to manufacturer and model. Printing machines may have different versions of software, since software professionals produce newer and more sophisticated systems on a regular basis. Variety in hardware and software allows a more competitive market place, which produces benefits for consumers and producers alike. OA, at 14 – **Agreed.**
- (11) Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include in Sevcik the use of various types of command sets, including copier command sets and direct-to-plate command sets. OA, at 14. – **Disputed for the same reasons listed above and also because of the impracticality of modifying the Sevcik system to not only provide a common marketplace for competing print providers, but also maintain the latest drivers for all of the latest printers, copiers, and press systems used or purchased by those print providers.**
- (12) "One of ordinary skill in the art at the time the invention was made would have been *motivated* to include in Sevcik the use of various types of command sets, including copier command sets and direct-to-plate command sets for the obvious reason that a single shop may have many different types of printing machines, depending on their specialties." OA, at 14 – **Disputed for the same reasons expressed above.**

- (13) “The inclusion of command sets may permit quicker processing of estimates . . . and reduce the amount of validation needed at a vendor [to provide] an estimate.” OA, at 14 – **Disputed.** **Sevcik contemplates an automated quote process already, without any validation. Sevcik therefore teaches that this additional information is not needed to provide a quote. As a matter of common sense, this kind of information (a complete pre-press product) is unnecessary to provide a quote. Alternatively, the costs of compiling this much information far outweigh the minimal, if any, benefit, of using it solely for the purpose of providing a quote. This supposed obscure advantage simply would not provide enough motivation to one of ordinary skill in the art to make the modification.**

As seen above, Applicant disputes some but not all of these assertions. Applicant particularly disputes the Examiner’s assertions that the common knowledge possessed by those of ordinary skill in the art would have motivated them to modify Sevcik in the manner recited in the claims. The Examiner accused Applicant of failing to address all of the Examiner’s arguments in the previous Office Action.² But the Examiner’s own office action entirely disregarded the arguments made on page 13 of Applicant’s prior response. See MPEP 707.07(f) (“Where the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant’s argument and answer the substance of it.”).

The Examiner also remarked that the term “ready-to-print PDF” does not appear in Applicant’s specifications or claims. OA, at 5. However, the undersigned would stress that the plain and ordinary meaning of the term “prepress product” encompasses (in addition to the specification’s inclusion of commands to copiers and direct-to-plate systems) both a printed product (that may be, for example, printed on lesser quality paper or with different lesser quality inks) and a visual representation of a product to be printed (i.e., an almost-WYSIWIG on-screen computer monitor prepress proof) that closely approximates the final product to be printed.³ Page 17 of the specification contemplates that “the user requestor and/or purchasing agent could be given the opportunity to preview the finished product at the time of order entry or approval.”

Applicant respectfully asks that the section 103 rejection be withdrawn and the claims be allowed. In the alternative, Applicant asks that the Examiner produce an affidavit supporting those assertions regarding common knowledge that Applicant has indicated, above, that it disputes.

² The Examiner stated that the arguments in Applicant’s prior response “do not appear to traverse what Examiner regards as knowledge that would have been generally available to one of ordinary skill in the art at the time the invention was made.” OA, at 4. Applicant respectfully disagrees. To overcome a rejection, Applicant does not have to dispute each and every assertion made in the Office Action. Applicant does not dispute, for example, that at the time of Applicant’s invention, there were various types of prior art command sets, printing machines, and software. But Applicant clearly challenged the Examiner’s assertion that persons of ordinary skill in the art would have been *motivated* to modify Sevcik. See pages 8-15, and especially page 13, of Applicant’s Response to the February 11, 2003, Office Action. Applicant’s response was *unusually* thorough and complete.

³ See <http://desktoppub.about.com/cs/basic/g/prepressproof.htm>;
<http://desktoppub.about.com/library/weekly/aa112499.htm>.

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CONCLUSION

Having addressed all matters raised by the Examiner's September 10, 2003, Office Action, Applicants respectfully request that the claims be allowed.

Respectfully submitted,



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